

REMARKS / ARGUMENTS

The present application includes pending claims 1-25, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,978,144, issued to Choksi (hereinafter, Choksi), in view of U.S. Patent Application Publication No. 2003/0134650, issued to Sundar, et al. (hereinafter, Sundar). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

EXAMINER'S RESPONSE TO ARGUMENTS

The Final Office Action states the following in the "Response to Arguments" section:

Choksi is discussing a method and a system for managing real-time bandwidth in a wireless network. Choksi discusses the bandwidth allocation controller receiving a call admission request from the network. Therefore disclosing the limitation of "receiving from at least one of a first access point and a first switch, at least a first messaging protocol message for establishing a communication session." Choksi further discusses processing the call admission request by verifying if there is available bandwidth to create the communication, and that the radio link can be an 802.11 based WLAN link. Therefore discloses "responsive to said first messaging protocol message, determining an available communication bandwidth for at least a portion of the hybrid wired/wireless local area network."

See the Final Office Action at page 3. The Applicant points out that the "Response to Arguments" section is simply summarizing the arguments previously mentioned in the non-final Office Action mailed on December 18, 2006. In this regard, the Final Office Action has not responded to Applicant's specific arguments stated in pages 13-19 of the March 12, 2007 response.

The Applicant points out that Choksi relates only to wireless cell networks and does not relate to hybrid wired/wireless local area network (LAN), as recited in Applicant's claim 1, for example. Furthermore, Choksi does not disclose or suggest receiving of a protocol message by an access point or a switch within the hybrid wired/wireless LAN. In fact, Choksi does not disclose any signal processing with regard to an access point or a switch.

The Final Office Action further states the following:

It is understood in the art, that once a connection is allowed, the access point would be notified, but Choksi fails to specifically disclose this limitation.

See the Final Office Action at page 3. Initially, regardless of whether this statement is true or not, the Applicant notes that it appears that at least claim 1 is being rejected based on inherency. That is, the Final Office Action's statement above implies that once a connection is allowed, it is inherent that the access point would be notified.

The Applicant submits that a rejection based on inherency must include a statement of the rationale or evidence tending to show inherency. See Manual of Patent Examining Procedure at § 2112. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish

the inherency of that result or characteristic.” See *id. citing In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. **Inherency, however, may not be established by probabilities or possibilities.** The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Applicant respectfully submits that neither Choksi itself nor the Final Office Action “make[s] clear that the missing descriptive matter,” said to be inherent “is necessarily present in” Choksi.

A rejection based on inherency must be based on factual or technical reasoning:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

The Applicant respectfully submits that the Final Office Action does not contain a basis in fact and/or technical reasoning to support the rejection based on inherency. Instead, as recited above, at least claim 1 of the present application

stands rejected based on a conclusory statement of inherency, rather than upon a "basis in fact and/or technical reasoning." Accordingly, the Applicant respectfully submits that, absent a "basis in fact and/or technical reasoning" for the rejection of record, that rejection should be reconsidered and withdrawn.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)).

Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...,” citing *AI-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

I. The Proposed Combination of Choksi and Sundar Does Not Render Claims 1-25 Unpatentable

The Applicant turns to the rejection of claims 1-25 as being unpatentable over Choksi in view of Sundar. The Applicant notes that the proposed combination of Choksi and Sundar forms the basis for all of the pending rejections.

A. Independent Claim 1

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that the combination of Choksi and Sundar does not disclose or suggest at least the limitation of “receiving from at least one of a first access point and a first switch, at least a first messaging protocol message for establishing a communication session,” as recited by the Applicant in independent claim 1.

The Final Office Action states the following:

Choksi discloses a method for providing bandwidth management in a hybrid wired/wireless local area network (*Abstract*), the method comprising:

receiving from at least one of a first access point and a first switch, at least a first messaging protocol message for establishing a communication session (*call admission request is submitted - Column 7, Lines 5-15 and 33-41*);

See the Final Office Action at page 5. Initially, the Examiner is reminded that the Applicant's claim 1 relates to a method for providing bandwidth management in a **hybrid wired/wireless local area network (LAN)**. However, the Examiner is relying for support on Choksi, which discloses a method and system for managing real-time bandwidth requests in a **wireless network** that includes receiving a request for a connection for bandwidth of a cell of a wireless network. See Choksi at Abstract. In this regard, **Choksi relates only to wireless cell networks and does not relate to a hybrid wired/wireless LAN**.

With regard to the first claim limitation stated above, the Examiner is relying on the following citations from Choksi:

Referring to FIG. 3, the method begins at state 160 in which the bandwidth request control is idle while there are no requests to be processed. In response to a bandwidth request for a connection, idle state 160 transitions to step. At step 162, the type of the request is determined. The request may be a handoff request, a call admission request, an additional bandwidth request or any other suitable type of request for bandwidth for a wireless

connection. Proceeding to step 162, a QoS policy is retrieved for the connection. The QoS policy may be retrieved from a SLA or other suitable database or node of the communications network 10.

FIG. 4 illustrates a method for bandwidth allocation control in accordance with one embodiment of the present invention. In this embodiment, as previously described in connection with FIG. 3, a single bandwidth request control is used to process call handoff, call admission and additional bandwidth requests. The bandwidth request control includes the call bandwidth and call handoff admission controls 72 and 74 and/or the functionality, thresholds and queues of the controls 72 and 74.

See Choksi at col. 7, lines 5-15 and 33-41. Figure 3 of Choksi illustrates a method for queuing a bandwidth request for allocation **in a wireless cell network**, and Figure 4 of Choksi illustrates a method for bandwidth allocation control **within the wireless cell network**. The Applicant points out that **Choksi, including the above citation of Choksi, does not disclose or suggest receiving by an access point or a switch, a messaging protocol message for establishing a communication session**, as recited in Applicant's claim 1. In fact, **Choksi does not disclose or suggest any signal processing with regard to an access point or a switch within a hybrid wired/wireless LAN**, as recited in Applicant's claim 1. Sundar is also silent as to receiving from an access point or a switch, a messaging protocol message for establishing a communication session, as recited by the Applicant in independent claim 1. Therefore, the proposed combination of Choksi and Sundar does not disclose or suggest at least the limitation of "receiving from at least one of a first access point and a first switch, at least a first messaging

protocol message for establishing a communication session,” as recited by the Applicant in independent claim 1.

Furthermore with regard to the rejection of claim 1, the Examiner concedes that Choksi fails to disclose the notification to the first access point of the communication system to commence the connection. See the Final Office Action at page 5. The Examiner then relies on Sundar and states the following:

In related prior art, Sundar et al. discloses a call connection management system for hybrid wired/wireless (WWAN and WLAN) networks which performs call setup functions such as channel assignment based upon requests from users. During the call connection setup, initiated by, for example, a handoff scenario, the service BSC informs the desired BSC of the desire to handoff, and once the operation is the complete, acknowledgements are returned to the initiating parties (*Figure 12 - Page 6, Paragraphs 0074-0075*).

See *id.* The Applicant points out that even though Sundar discloses that the service BSC informs the desired BSC of the desire to handoff, **Sundar fails to disclose or suggest that an access point is notified of allocated bandwidth using a messaging protocol message**, as recited by the Applicant in claim 1. The Applicant is confused as to why the Examiner is relying on Sundar as **Sundar clearly does not disclose or suggest any access point notification**. Therefore, the proposed combination of Choksi and Sundar does not disclose or suggest at least the limitation of “notifying said first access point of said allocated bandwidth using at least a second messaging protocol message,” as recited by the Applicant in independent claim 1.

Accordingly, the proposed combination of Choksi and Sundar does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is allowable. Independent claims 9 and 17 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 9 and 17 are also allowable over the references cited in the Final Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-8, 10-16 and 18-25

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 9 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Choksi in view of Sundar has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-8, 10-16 and 18-25 depend from independent claims 2-8, 10-16 and 18-25, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-25.

Application No. 10/658,725
Reply to Office Action of May 24, 2007

CONCLUSION

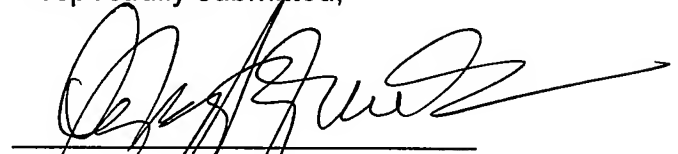
Based on at least the foregoing, the Applicant believes that all claims 1-25 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

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Respectfully submitted,



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